

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN E. KING and JAMES T. CARPENTER

Appeal No. 1998-0503
Application 08/539,858¹

ON BRIEF

Before THOMAS, MARTIN, and BARRETT, Administrative Patent Judges.

MARTIN, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 2, 3, 7-11, 14, 15, and 17-35 under 35 U.S.C. § 103, with claim 36 standing objected to for depending on a rejected claim.² We reverse.

¹ Application filed October 6, 1995.

² The examiner's 35 U.S.C. § 112, second paragraph rejections of claim 9 for twice reciting "a switch" and of claim 15 as lacking an antecedent for "the base center axis" (Final Rejection at 2) were withdrawn in the Answer (at 11).

A. The invention

Referring to appellants' Figures 1 and 2, the invention is a mounting structure 10 including a base 38, an arm 40, and a switch mount 42, which structure is depicted being used to mount a switch 32 to the end wall 16 of a motor housing 14 using a screw and nut fastener 74 (the screw passes through bore 52 in the base). The distance between the end-wall-engaging surface of base 38 and the corresponding end of the arm 40 is selected to cause the arm to crimp the switch wires 34 and 36 between the arm and the end wall (Spec. at 13, lines 11-16).

B. The claims

Claim 7 is representative:

7. An apparatus for securing lead wires of an electric switch to a device casing surface to hold the wires securely to the device casing surface, the apparatus comprising:

a base separate from the device casing, an arm projecting from the base, and the base having means for attaching the base to the device casing surface with the arm spaced from the device casing surface a set distance, the set distance being sufficiently small to cause the arm to crimp lead wires of a switch positioned between the arm and the device casing surface when the base is attached to the devise [sic] casing surface; and

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at least one clasp connected to and supported by the base, the clasp having means for grasping and holding a switch to the base.

C. The references and rejections

The following U.S. patents are relied on by the examiner:

Pate et al. (Pate)	4,209,661	Jun. 24,
1980		
Botz et al. (Botz)	4,398,073	Aug. 9,
1983		
Morawa et al. (Morawa)	5,411,228	May 2,
1995		
		(filed Dec. 16,
1993)		

Claims 2, 7-11, 15, 17-22, 26-30, and 32-35 stand rejected under § 103 for obviousness over Morawa in view of Botz.

Claims 3, 14, 23-25, and 31 stand rejected under § 103 for obviousness over Morawa in view of Botz and Pate.

D. The merits of the rejection based on Morawa in view of Botz

Morawa discloses an improved cable clip for retaining coaxial cables and the like against a mounting surface (col. 1

lines 6-8). Typically, such clips are used to hold an insulated electrical cable to a building structure such as a floor, wall or roof (col. 1, lines 15-17). Morawa's clip differs from prior art clips by including fastener retainer means for holding a fastening device in place relative to the clip prior to installation (col. 1, lines 9-11). This is accomplished using a plurality of segmented wall portions 26 (Figs. 4-6) for gripping a screw 24, shown in Figure 7.

Appellants do not challenge the examiner's position that the claimed base and arm read on Morawa's clip in the manner shown in the annotated copy of Morawa's Figure 1 that appears at (unnumbered) page 9 of the brief.

For a suggestion of modifying Morawa by adding the claimed "at least one clasp connected to and supported by the base, the clasp having means for grasping and holding a switch to the base," the examiner relies on Botz, which shows a fastening arrangement which permits snap-in assembly of a switch to a panel or receiving member (Abstract, lines 1-2). A push-button switch is held in place in a cavity formed by side walls 72 by means of a connector 84 holding elements 75

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with lugs which releasably engage shoulders 79 of the side walls.

We agree with appellants that the examiner's proposed motivation for combining the teachings of Morawa and Botz, i.e., "for easy yet precise mounting of a switch" (Answer at 12), is based, improperly, on hindsight obtained from appellants' disclosure. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references [Citations omitted]."). As already noted, Morawa's clip is designed to be fastened to a floor, wall, or roof. The examiner has not satisfactorily explained why one skilled in the art would have seen in Morawa and Botz any suggestion to mount a switch or any other electrical device on such a clip.

Accordingly, the rejection based on Morawa in view of Botz is reversed as to all of the claims rejected thereover.

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Because Pate does not cure the above-noted deficiency,
the rejection based on Morawa in view of Botz and Pate is
reverse as to call claims rejected thereover.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
JOHN C. MARTIN)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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LEE E. BARRETT)	
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